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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,432	01/24/2002	J. Benjamin Williams	FWP-100US	8067

7590

04/04/2003

Bruce M. Monroe
RATNER & PRESTIA
P.O. Box 7228
Wilmington, DE 19803

EXAMINER

LOCKER, HOWARD J

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 04/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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10056432

EXAMINER

ART UNIT	PAPER NUMBER
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2

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on January 24, 2002

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Claim(s)~~ The claim is ~~is~~ pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ ~~Claim(s)~~ The claim is ~~is~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on January 24, 2002 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

10056432
PTOL-326 (Rev. 10/95)

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

1. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A. The instant cultivar should be compared and contrasted to its stated antecedents on the record. Such need not be in any great detail, but should be to such extent that the instant cultivar is readily distinguished from same.

B. At the end of page 1, it is not clear what is encompassed by the phrase "transmitted through successful propagation". Such should be amended so as to clearly convey what was intended.

C. AS the instant cultivar has been asexually reproduced by budding, the specification should mention the rootstock plant, at least by Genus and species.

D. The Genus/species of the instant plant should be set forth in the specification.

E. The information currently set forth relative to sepals does not read clearly, as the length of same set forth does not appear to reasonably correspond to the bud length. In addition, that three of the sepals are "normally appendaged" and yet fall within the length designations currently set forth in the specification does not appear to be reasonable or accurate. Additional information and/or clarification is necessary.

F. It is not understood what is intended or encompassed by "cup shaped" relative to shape of the petals.

G. As some hips have been observed, the botanical description of the plant should contain some reference to physical characteristics of same.

H. Some mention as to characteristic leaflet sheen (or lack thereof) should be imported into the specification. In this regard, the foliage illustrated would appear to bear a glossy upper surface.

I. It is not understood what is intended or encompassed by "Rust - not observed" as recited at page 5 of the specification. Does this mean that resistance to same has not been observed or that rust itself has not been observed?

J. The bloom color illustrated does not appear to reasonably correspond to that set forth in the specification, as the bloom color illustrated appears to be distinctly red-purple in coloration rather than dark red. Correction and/or clarification relative to this issue is necessary responsive to this Office action. If the source of the noted discrepancy is in the photographic illustration itself, it may be necessary for applicant to file a substitute photographic illustration(s) (in duplicate) which more reasonably and accurately sets forth the true bloom coloration of the plant (see also paragraph 3 below for additional issues relating to the photographic illustrations currently of record).

K. The "BRIEF DESCRIPTION OF THE ILLUSTRATION" section of the specification should be amended so as to more accurately set forth what is illustrated. The vegetative growth does not appear to be meaningfully illustrated in the photographic illustration currently of record.

The above listing may not be comprehensive. Applicant should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 1 above.

3. Applicant is advised of the changes to 37 CFR 1.84 which took effect November 29, 2000 and apply to any applications (and to new drawings filed in previously existing applications) filed thereafter. In particular, 37 CFR 1.84(e) now states, in part:

Photographs must be developed on paper meeting the sheet size requirements of paragraph (f) of this section and margin requirements of paragraph (g) of this section.

The USPTO no longer accepts photographs mounted on Bristol board, paper or other material. Further information on the new rules is available on the USPTO web site at www.uspto.gov.

The USPTO has delayed enforcement of the above changes until October 01, 2001. Drawings in compliance with old rules will be accepted through September 30, 2001. Complete details can be found in the May 22, 2001, Official Gazette (1246 OG 106-107) on the internet at:
<http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>

The photographic illustration currently of record (in duplicate) is objected to as it is a mounted photograph.

4. Applicant is advised of the new procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until February 28, 2001 and **mandatory** beginning March 01, 2001. Information on the new procedures is available on the internet at <http://www.uspto.gov/web/offices/dcom/olia/pbg/index.html>.

5. Applicant is advised of the new optional procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until July, 2003, and such may become mandatory at that time. Applicant may review same on the internet at the following site: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

6. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campbell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Serial No. 10/056432
Art Unit 1661

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TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

April 01, 2003



HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT *1661*